



F A X C O V E R

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Date: February 27, 2004 **Number of pages (including cover):** 3
To: Examiner Jon P. Weber, U.S. Patent and Trademark Office
Fax No.: 571-273-0925
Serial No.: 09/886,964
Title: MLK INHIBITORS FOR TREATMENT OF NEUROLOGICAL DISORDERS
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Our File #: L0624.70001US00

CERTIFICATE OF FACSIMILE TRANSMISSION 37 C.F.R. §1.8(a)

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Melissa L.B. Lyons

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Ya Fang Liu Serial No: 09/886,964
Confirmation No: 6742 Filed: June 21, 2001
For: MLK INHIBITORS FOR TREATMENT OF
NEUROLOGICAL DISORDERS
Examiner: Jon P. Weber Art Unit: 1651

CERTIFICATE OF FACSIMILE TRANSMISSION 37 C.F.R. §1.8(a)

The undersigned hereby certifies that this document is being facsimile transmitted to the United States Patent and Trademark Office in accordance with 37 C.F.R. §1.6(d) to the attention of Examiner Weber, Art Unit 1651, Technology Center 1600, Patent and Trademark Office, Washington, D.C. 20231, FAX number 571-273-0925, on the 27th day of February, 2004.


Melissa L. Lyons

Attn: Examiner Weber
Commissioner for Patents
Washington, D.C. 20231

INFORMAL COMMUNICATION

Sir:

Further to the telephonic interview between Examiner Weber and Applicant's representative on February 26, 2004. Applicant's representative sets forth herein the basis for Applicant's request that the Examiner to withdraw the finality of the Office Action mailed October 31, 2003 (the second Office Action).

Applicant submits that the Final Office Action mailed October 31, 2003 includes grounds for the rejection of claims 36, 39, 40, 43, and 44 under 35 U.S.C. §112, first paragraph that were not presented in the first Office Action, which was mailed February 13, 2003 (the first Office Action). As indicated in the MPEP 706.07(a), a final Office Action is not proper on second action if the Examiner has introduced a new ground of rejection that is neither necessitated by Applicant's amendment of the claims nor based on information submitted in an information disclosure statement. Applicant asserts that an information disclosure statement was not filed following the first Office Action and that the amendments to the claims in the response to the first Office Action were made solely to comply with the restriction requirement.

The Examiner indicated in the first Office Action that claims 36-43 were rejected under 35 U.S.C. §112, first paragraph as lacking guidance with respect to finding suitable compounds for screening. At page 5 of the first Office Action, the Examiner states: "The instant

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specification provides absolutely no guidance as the structure of any suitable compounds to be used in the treatment method" and concludes at page 7, "... the instant specification does not provide the guidance needed to predictably produce compounds with any reasonable expectation that the resulting compounds will function as a therapeutic for Parkinson's."

In contrast to the grounds presented by the Examiner in the first Office Action, in the rejection of claims 36, 39, 40, 43, and 44 under 35 U.S.C. §112, first paragraph in the second Office Action, the Examiner states for the first time that the disclosure does not enable *in vivo* use of compounds and that the "standard of enablement is higher for such inventions because effective treatments for disease conditions are relatively rare and may be unbelievable in the absence of strong supporting evidence." (see second Office Action, at page 3).

Applicant respectfully submits that the introduction of enablement issues relating to therapy is a new ground for the §112, first paragraph rejection, and therefore is a basis for the rejection that Applicant was given no opportunity to address prior to the issuance of the second (final) Office Action. Applicant submits that the "therapeutic enablement" basis of the rejection is a new ground for the rejection of the claims, which differs substantially from the "compound selection" grounds on which the rejection was presented in the initial Office Action. Accordingly, Applicant requests the Examiner withdraw the finality of the second Office Action to afford Applicants the opportunity to address the new basis for the rejection in advance of the issuance of a Final Office Action in the case.

On the basis of the arguments provided herein, Applicant respectfully requests the Examiner to reconsider and withdraw the finality of the Office Action mailed October 31, 2003.

Respectfully submitted,
Ya Fang Liu, Applicant

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